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In the Supreme Court of the United States

STAR ATHLETICA, L.L.C., PETITIONER

v.

VARSITY BRANDS, INC., ET AL.

ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT

BRIEF FOR THE UNITED STATES AS AMICUS CURIAE SUPPORTING RESPONDENTS

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QUESTION PRESENTED

Whether respondents' two-dimensional decorations for the surface of a garment, if sufficiently original, are protected by copyright.

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INTEREST OF THE UNITED STATES

This case concerns the copyrightability of two-dimensional decorations for the surface of a garment. The Register of Copyrights, who directs the United States Copyright Office, is responsible for, *inter alia*, examining applications for copyright registration and determining whether "the material deposited constitutes copyrightable subject matter." 17 U.S.C. 410(a). The United States therefore has a substantial interest in the disposition of this case.

STATEMENT

1. The Copyright Clause empowers Congress to grant term-limited rights of exclusivity to the creator of "any physical rendering of the fruits of creative or aesthetic labor." *Goldstein* v. *California*, 412 U.S. 546, 561 (1973); see U.S. Const. Art. I, § 8, Cl. 8. For more than a century, distinct and identifiable creative

expression appearing in or on objects with utilitarian functions has been understood to fall within the scope of statutory copyright protection.

a. The Copyright Act of 1909 eliminated any "[v]erbal distinctions between purely aesthetic articles and useful works of art" by identifying all "'works of art'" and "'reproductions of works of art'" as copyrightable subject matter. *Mazer* v. *Stein*, 347 U.S. 201, 211, 214 (1954) (quoting Act of Mar. 4, 1909, ch. 320, § 5(g)-(h), 35 Stat. 1077). In the ensuing decades, the United States Copyright Office regularly registered copyrights in "works of art possessing utilitarian aspects," *id.* at 212, such as a "[p]late with [an] acorn and oak leaf pattern," Gov't Amicus Br. App. B, at 64, *Mazer*, *supra* (No. 53-228); see 1909 Act § 10, 35 Stat. 1078. The Copyright Office's registration regulations explained that copyrights in such "[w]orks of art" were limited to their "form," and did not include their "mechanical or utilitarian aspects." 37 C.F.R. 202.8 (1949) (emphasis omitted); see *Mazer*, 347 U.S. at 218; see also 1909 Act, § 53, 35 Stat. 1085 (rulemaking authority).

In 1954, in *Mazer* v. *Stein*, this Court upheld the validity of copyrights in "statuettes * * * intended for use and used as bases for table lamps." 347 U.S. at 202. The Court explained that Congress's "successive acts, the legislative history of the 1909 Act and the practice of the Copyright Office unite[d] to show" that the statuettes were protected. *Id.* at 213. The Court held, in particular, that the "patentability of the statuettes * * * does not bar copyright as works of art." *Id.* at 217. It emphasized that, because a copyright covers only "the expression of [an] idea—not the idea itself," others remained free to "us[e] statuettes of hu-

man figures in table lamps," provided they did not copy the specific statuettes at issue. *Id.* at 217-218.

b. The Copyright Office subsequently issued additional regulatory guidance about the registration of works of art appearing in or on useful objects. See 24 Fed. Reg. 4958 (June 18, 1959); 21 Fed. Reg. 6024 (Aug. 11, 1956). As ultimately amended, the regulations advised that, "[i]f the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art." 37 C.F.R. 202.10(c) (1960). The regulations recognized, however, that "if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration." *Ibid.* The regulations also stated that "[t]he registrability of a work of art is not affected by * * * the fact that it appears on a textile material or textile product." 37 C.F.R. 202.10(b) (1960).

During the 1950s, the Copyright Office registered copyrights in a number of works intended as surface decorations for wearable items, such as the following "Apron Design":

Fig. 1: "Apron Design," No. Gu24769 (1955)

c. In a 1961 report, the Register of Copyrights informed Congress that, "[i]n the light of the *Mazer* case, the Copyright Office has registered a rapidly increasing number of claims in 'works of art' that are embodied in useful articles, including fabrics, jewelry, lace, dishes, glassware, silverware, lamps, clocks, ashtrays, and the like." House Comm. on the Judiciary, 87th Cong., 1st Sess., *Copyright Law Revision: Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law* 12 (Comm. Print 1961) (*1961 Register Report*). The Register stated that "full protection under the copyright law has not proved inappropriate for 'works of art' used as a design or decoration of useful articles." *Id.* at 13.

In his report, the Register distinguished between "'works of art' used as a design or decoration *of* useful

articles," which he recognized copyright law to protect, and "designs of useful articles *as such*" (and "industrial designs"), which he identified as noncopyrightable. *1961 Register Report* 13 (emphases added). That latter, unprotected category included "wearing apparel," *ibid.*, such as "a dress," *id.* at 14. The Register explained that a dress would not be "accepted for deposit and registration by the Copyright Office," and that a copyright in a "picture of a dress" would not encompass an exclusive right "to manufacture the dress," *ibid.*, because that sort of protection would require "a sui generis design protection statute," *id.* at 13. The Register stated, however, that even "under the present law," an otherwise-copyrightable work "used as a design or decoration of a useful article" was "protected by copyright if the owner wishes." *Id.* at 14. For example, an otherwise-copyrightable "painting," "cartoon drawing," or "photograph" remained copyright-eligible when "reproduced on fabrics." *Ibid.*

Under the administrative practice of the Copyright Office, "virtually all original two-dimensional designs for useful articles, such as textile fabrics, wallpaper, floor tiles, painted or printed decorations, and so forth, were subject to copyright registration." *Copyright Law Revision: Hearings Before the Subcomm. on Courts, Civil Liberties and the Administration Of Justice of the House Comm. on the Judiciary*, 94th Cong., 1st Sess. 1857 (1975) (statement of Barbara Ringer, Register of Copyrights) (*1975 Hearing*). In fiscal year 1975 alone, the Copyright Office registered 9600 copyrights "covering designs for useful articles." *Ibid.* The Copyright Office continued to register copyrights in surface decoration for clothing, such as the following design for a t-shirt in which the wearer

would appear to be in the grasp of a giant 1930s movie ape:

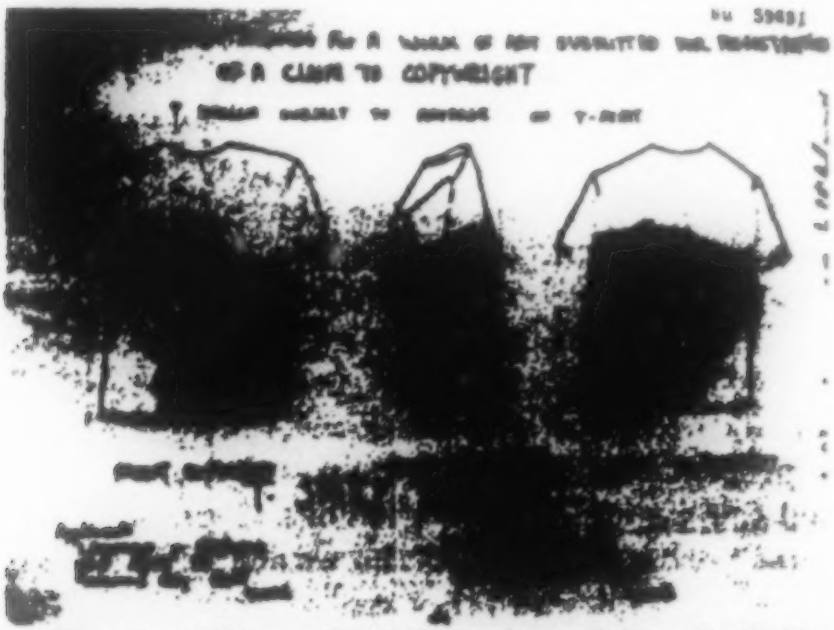

Fig. 2: "'Kong-Shirt' Designs," No. Gu59691 (1976)

d. In 1976, Congress enacted a new version of the Copyright Act, the relevant portions of which remain largely unchanged today. See Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541. Congress declined to enact *sui generis* protection for "industrial designs." H.R. Rep. No. 1476, 94th Cong., 2d Sess. 50, 54 (1976) (1976 House Report). "In accordance with" *Mazer*, however, Congress sought to define the set of copyrightable works to "encompass all original pictorial, graphic, and sculptural works that are intended to be or have been embodied in useful articles, regardless of factors such as mass production, commercial exploitation, and the potential availability of design patent protection." *Id.* at 54.

In its current form, the Copyright Act protects "original works of authorship fixed in any tangible medium of expression." 17 U.S.C. 102(a). Consistent with a recommendation in the Register's 1961 report, the Act defines such copyrightable "[w]orks of authorship" to include "pictorial, graphic, and sculptural works," 17 U.S.C. 102(a)(5), a category that encompasses, *inter alia*, "two-dimensional and three-dimensional works of fine, graphic, and applied art," 17 U.S.C. 101; see *1961 Register Report*, App. B, at 149.

The owner of a copyright in a pictorial, graphic, or sculptural work generally enjoys the exclusive right to copy it. 17 U.S.C. 106(1). That right includes, with certain limitations, "the right to reproduce the work in or on any kind of article, whether useful or otherwise." 17 U.S.C. 113(a). The Act defines a "useful article" as "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." 17 U.S.C. 101. "An article that is normally a part of a useful article is considered a 'useful article.'" *Ibid.*

Relevant portions of the statutory definition of "'pictorial, graphic, and sculptural works'" are "drawn from," or "an adaptation of," preexisting Copyright Office regulations. 1976 House Report 54. First, the definition provides that such works "shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned." 17 U.S.C. 101; see 37 C.F.R. 202.10(a) (1976). Second, it instructs that "the design of a useful article * * * shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately

from, and are capable of existing independently of, the utilitarian aspects of the article." 17 U.S.C. 101; see 37 C.F.R. 202.10(c) (1976).

e. After Congress codified substantial portions of the Copyright Office's regulations, superseding the 1909 Act language that those regulations had interpreted, the Copyright Office largely repealed them. See 43 Fed. Reg. 965-966 (Jan. 5, 1978); see also 46 Fed. Reg. 33,248-33,249 (June 29, 1981). Since 1984, the Copyright Office has provided guidance on the circumstances in which a pictorial, graphic, or sculptural work will be considered "separable" from a useful article, and thus eligible for copyright registration if sufficiently creative, primarily through the publication of its *Compendium of U.S. Copyright Office Practices*. See U.S. Copyright Office, *Compendium of U.S. Copyright Office Practices* Preface, §§ 505.02-505.05 (2d ed. 1984) (*Compendium II*); U.S. Copyright Office, *Compendium of U.S. Copyright Office Practices* § 924.2 (3d ed. 2014) (*Compendium III*).

Tracking language in the 1976 House Report, the current *Compendium III* explains that separability can be either "physical" or "conceptual." *Compendium III* § 924.2; see 1976 House Report 55 (referring to elements that, "physically or conceptually, can be identified as separable"). "Physical separability means that the useful article contains pictorial, graphic, or sculptural features that can be physically separated from the article by ordinary means while leaving the utilitarian aspects of the article completely intact." *Compendium III* § 924.2(A). Conceptual separability is present when "the artistic feature and the useful article," even if not physically separable, "could both exist side by side and be perceived as fully realized,

separate works—one an artistic work and the other a useful article." *Id.* § 924.2(B); see *Compendium II* § 505.03.

The Copyright Office has distinguished between "three-dimensional aspects of clothing," which generally are not copyrightable, and "two-dimensional design applied to the surface of the clothing," which "may be registered." 56 Fed. Reg. 56,531 (Nov. 5, 1991); see *ibid.* (observing that, in practice, registration of two-dimensional designs often occurs at the fabric-production stage). The Copyright Office "will not register a claim in clothing or clothing designs" because items of "[c]lothing such as shirts [and] dresses" are "useful articles," *Compendium III* § 924.3(A), and three-dimensional clothing features ordinarily lack "artistic authorship separable from [the clothing's] overall utilitarian shape," 56 Fed. Reg. at 56,531. "[D]esigns imprinted in or on fabric," however, "are considered conceptually separable from the utilitarian aspects of garments." *Compendium III* § 924.3(A)(1). Thus, "[a]rtwork printed on a t-shirt," *id.* § 924.2(B), or "a fabric design * * * use[d] * * * to produce a * * * dress," *id.* § 924.3(A)(1), is treated as potentially copyrightable, even though a "dress itself" would not be, *ibid.*

The Copyright Office has accordingly continued, following the 1976 Act, to register copyrights in clothing decoration, such as the following design in which a t-shirt is made to resemble a tuxedo:

Fig. 3: "Tuxedo T-Shirt," No. VA0001930383 (2014)

2. a. Respondents design and manufacture athletic clothing. Pet. App. 3a. On several occasions they have sought and received copyright registration for "two-dimensional" decorations for garments sold as cheerleading apparel. *Id.* at 4a. The Copyright Office based its decisions to register those decorations on specific materials that respondents were required to deposit with their registration applications. See 17 U.S.C. 408(b), 410.

The deposit materials for five of respondents' works are reproduced in the petition appendix. Pet. App. 5a-9a. Where the deposit materials were drawings, registrations were issued for "2-dimensional artwork." J.A. 38, 46, 71. Where the deposit materials were photographs of the decorations on actual garments, registrations were issued for "fabric design (artwork)." J.A. 48, 57 (capitalization altered).

b. Those five works are at issue in an infringement suit filed by respondents against petitioner, another company that sells apparel to cheerleaders. Pet. App.

10a. Respondents allege that petitioner has been "selling, distributing, and advertising" products with decorations substantially similar to the decorations respondents have registered. *Ibid.* (brackets and citation omitted).

The district court granted petitioner's motion for summary judgment on the infringement claims. Pet. App. 58a-78a. The court did not address petitioner's argument that respondents' works lack sufficient originality to qualify for copyright protection. *Id.* at 12a. Instead, treating each of respondents' works as the "'design of a useful article'"—namely, a "cheerleading uniform"—the court concluded that the works did not qualify for copyright protection because they lacked any "'pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." *Id.* at 71a-72a (emphasis omitted) (quoting 17 U.S.C. 101); see *id.* at 71a-75a. The court described the "utilitarian function" of a "cheerleading uniform" as "not merely to clothe the body," but to "clothe the body in a way that evokes the concept of cheerleading." *Id.* at 74a. It thus viewed "the presence of * * * designs and colors" like those in respondents' decorations as lying "at the core of the ideal * * * of 'cheerleading-uniform-ness,'" conceptually inseparable from the uniform itself. *Id.* at 59a.

c. The court of appeals reversed and remanded. Pet. App. 1a-53a. Applying a five-step approach, it determined that respondents' works are of a type that, if sufficiently original, qualifies for copyright protection. *Id.* at 37a-53a.

First, the court of appeals classified respondents' works as "two-dimensional works of . . . graphic

. . . art," and thus within a subcategory of "pictorial, graphic, or sculptural works." Pet. App. 42a (quoting 17 U.S.C. 101). Second, the court concluded that, because respondents' works "depict cheerleading crop tops and skirts—the components of a cheerleading uniform," those works should be treated as "'design[s] of useful article[s]'" for purposes of copyrightability. *Ibid.* (ellipses omitted; brackets in original) (quoting 17 U.S.C. 101).

Third, the court of appeals reasoned that the "'utilitarian aspects'" of a "cheerleading uniform" are "cover[ing] the body, wick[ing] away moisture, and withstand[ing] the rigors of athletic movements," and do not include "identify[ing] the wearer as a cheerleader and a member of a cheerleading team." Pet. App. 43a (citation omitted). The court relied in part on "the Copyright Act's definition of what makes an article a useful article," *id.* at 38a, a definition that expressly excludes "convey[ing] information," 17 U.S.C. 101. The court also rejected petitioner's assertion that respondents' works are intrinsically utilitarian (and thus ineligible for copyright) because they serve a "decorative function," reasoning that such an approach "would render nearly all artwork unprotectable." Pet. App. 43a-44a.

Fourth, the court of appeals determined that respondents' "graphic design concepts can be identified separately from the utilitarian aspects of the cheerleading uniform." Pet. App. 46a. The court explained that respondents' decorations "do not enhance the cheerleading uniform's functionality *qua* clothing" because a "plain white" uniform would "still cover the body and permit the wearer to cheer, jump, kick, and flip." *Id.* at 45a (internal quotation marks, brackets,

and citation omitted). Applying the Copyright Office's conceptual-separability framework, the court reasoned that "a graphic design and a blank cheerleading uniform can appear 'side by side'—one as a graphic design, and one as a cheerleading uniform." *Id.* at 46a (quoting *Compendium III* § 924.2(B)).

Fifth, the court of appeals determined that respondents' works can "'exist[] independently of' the utilitarian aspects of a cheerleading uniform." Pet. App. 46a (brackets in original) (quoting 17 U.S.C. 101). The court observed, *inter alia*, that respondents' decorations could "be incorporated onto the surface of a number of different types of garments, including cheerleading uniforms, practice wear, t-shirts, warm-ups, and jackets." *Ibid.* (citation omitted). The court distinguished such decorations from a full-on "dress design" that "graphically sets forth the shape, style, cut, and dimensions for converting fabric into a finished dress or other clothing garment," which would be conceptually inseparable from the garment itself and thus not copyrightable. *Id.* at 48a (quoting 1 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 2.08[H][1] (2012) (Nimmer)).

Judge McKeague dissented. Pet. App. 53a-57a. In his view, respondents' works are conceptually inseparable from the utilitarian functions of a cheerleading uniform because one of those functions is to "identify the wearer as a cheerleader." *Id.* at 53a.

SUMMARY OF ARGUMENT

Respondents' works, if sufficiently original, are protected by the Copyright Act. The Act, which embodies principles recognized by this Court in *Mazer* v. *Stein*, 347 U.S. 201 (1954), and long reflected in Copyright Office practices, treats a garment with two-

dimensional surface decoration as having two distinct components. The first, the surface decoration, is a copyrightable "work[] of authorship," 17 U.S.C. 102(a). The second, the garment itself, is a noncopyrightable "medium of expression," *ibid.*, on which that work may be displayed.

A. Although it was not the focus of the proceedings below, the most straightforward way to approach this case is through application of 17 U.S.C. 113(a), which grants the owner of a copyright in a pictorial, graphic, or sculptural work the "exclusive right * * * to reproduce the work in or on any kind of article, whether useful or otherwise." Under Section 113(a), if an artist draws something, his permission is required before the drawing may be reproduced on a garment. That principle applies no less to a drawing of garment decorations than to a drawing of anything else. An artist who draws a decorated garment would not gain any exclusive right to manufacture an *undecorated* garment of the same cut and shape as the one he has depicted. 17 U.S.C. 113(b). But he would have the exclusive right to reproduce his *original decoration* on any useful article, including such a garment. 17 U.S.C. 113(a).

Petitioner does not dispute that the drawings respondents deposited with the Copyright Office are copyrightable as drawings. At the present stage of the case, the creativity of the decorations those drawings depict likewise is not at issue. If the decorations are assumed to reflect the minimal degree of originality that the Copyright Act requires, respondents have the exclusive right under Section 113(a) to reproduce them on any medium of display, including any type of garment. Neither identifying the wearer as a cheer-

leader, nor altering the viewer's perception of the garment or its wearer, alters any "intrinsic utilitarian function" of a garment "that is not merely to portray the appearance of the article or to convey information." 17 U.S.C. 101. And because "[c]opyright protection subsists * * * in original works of authorship fixed in any tangible medium of expression," 17 U.S.C. 102(a), respondents enjoy the same exclusive rights of reproduction in the decorations for which their deposit materials showed the decorations on garments, rather than on paper.

B. The result is the same if respondents' works are viewed (in accord with the approach of the parties and courts below) as "design[s] of a useful article," 17 U.S.C. 101. In symmetry with Section 113, the Act protects such a design to the extent that it *could be viewed* as a freestanding work that is being displayed on the medium of a useful article—*i.e.*, to the extent that it "can be identified separately from, and [is] capable of existing independently of," the useful article's "utilitarian aspects," *ibid.* Under the Copyright Office's longstanding approach, which provided the model for the current statutory text, an artistic feature of a useful article is eligible for copyright protection so long as "the artistic feature and the useful article could both exist side by side and be perceived as fully realized, separate works—one an artistic work and the other a useful article." *Compendium III* § 924.2(B).

As the court of appeals recognized, that condition is satisfied here. Respondents' decorations can be and have been reproduced in other media, aside from the garments depicted in respondents' deposit materials. And those decorations are distinct from the aspects of

a garment (or any other article) that make it "useful" under the Copyright Act. Although the decorations may look (and apparently are designed to look) best on garments of particular shapes, such spatial symbiosis can be found in essentially any work that could plausibly be described as the "design of a useful article."

C. Petitioner's restrictive view of copyrightability is misconceived. Nothing in the Copyright Act, which incorporates preexisting regulatory language that authorized the registration of many designs of useful articles, supports a presumption against the copyrightability of a work that can be characterized as such a design. The Act likewise does not suggest that the "design process" or "marketability" of a work is relevant to its copyrightability. And because copyright law confers exclusivity only over *particular* expression, treating specific designs as copyrightable would not permit respondents to monopolize all decorations evocative of cheerleading.

ARGUMENT

RESPONDENTS' TWO-DIMENSIONAL GARMENT DECORATIONS, IF SUFFICIENTLY ORIGINAL, ARE COPYRIGHTABLE

The Copyright Act codifies longstanding administrative practice, approved by this Court in *Mazer* v. *Stein*, 347 U.S. 201 (1954), under which two-dimensional surface decoration for a garment has been treated as copyrightable. The Act distinguishes in two symmetric ways between the decoration itself, which is a copyrightable expressive work, and the garment on which it may be displayed, which is a noncopyrightable useful article. First, the Act provides that a copyright in a pictorial or graphic work,

including a representation (*e.g.*, a drawing) of decoration for a garment, confers the exclusive right to reproduce that work in or on any useful or nonuseful article, including the particular type of garment for which the decoration is intended. 17 U.S.C. 113(a). Second, if viewed as the "design of a useful article," the decoration remains copyrightable because it *could* be represented as an independent work, and is thus conceptually separate from the useful article itself, 17 U.S.C. 101. Although the proceedings below focused on the latter approach, they are equivalent, and both illustrate that respondents' works, if sufficiently original, are copyrightable.

A. Respondents Have Created Two-Dimensional Artwork, Which They Would Have The Exclusive Right To Reproduce On Any Display Medium, Including Any Garment

1. The Copyright Act classifies "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information" as a "useful article." 17 U.S.C. 101. Clothing is a useful article because it "provides utilitarian functions, such as warmth, protection, and modesty." *Compendium III* § 924.3(A). The Act does not provide copyright protection for useful articles.

Under 17 U.S.C. 113(a), however, "the exclusive right to reproduce a copyrighted pictorial, graphic, or sculptural work * * * includes the right to reproduce the work in or on any kind of article, whether useful or otherwise." That rule codifies "the basic principle established" in *Mazer*, "that copyright in a pictorial, graphic, or sculptural work * * * will afford protection to the copyright owner against unauthorized reproduction of his work in useful as well as

nonuseful articles." 1976 House Report 105; see *Mazer*, 347 U.S. at 218.

It is therefore undisputed that a copyright in a pictorial work extends to the reproduction of that work on a garment. In particular, although petitioner's brief does not cite Section 113(a), petitioner recognizes (Br. 54) that the owner of a copyright in Vincent Van Gogh's *The Starry Night* would have the exclusive right to print it on a dress:

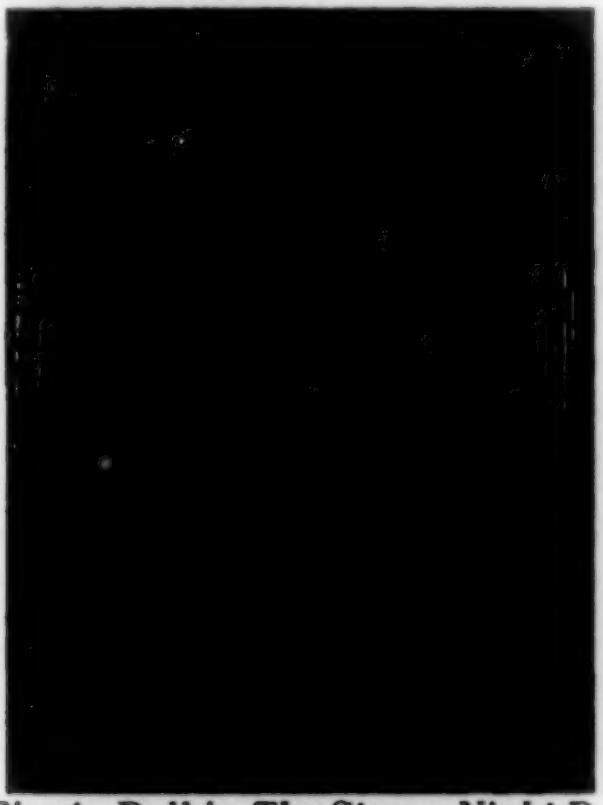

Fig. 4: Doll in *The Starry Night* Dress

2. The exclusive right to reproduce a pictorial work on clothing would apply equally to a copyright in the following painting by Gustav Klimt, which itself depicts a dress:

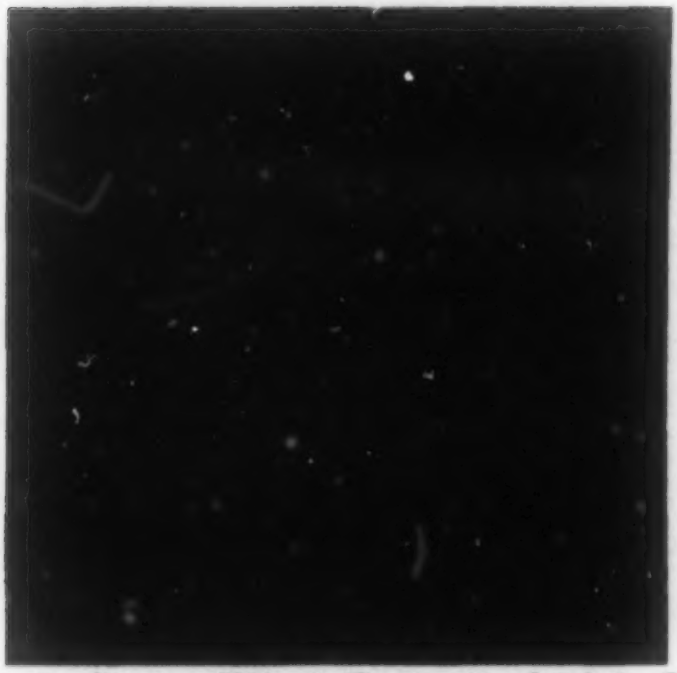

Fig. 5: Gustav Klimt, *Portrait of Adele Bloch-Bauer I* (1907)

Klimt appears to have imagined the dress in the painting rather than basing it on an actual dress, see Susan Stamberg, *Immortalized as "The Woman in Gold," How a Young Jew Became a Secular Icon*, NPR (June 23, 2015), http://www.npr.org/2015/06/23/416518188/immortalized-as-the-woman-in-gold-how-a-young-jew-became-a-secular-icon, and the painting clearly exhibits the "modicum of creativity" that is required for copyright protection, *Feist Publ'ns, Inc.* v. *Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991). Accordingly, the scope of a copyright in the Klimt painting would be the same as the scope of a copyright in *The Starry Night*.

Klimt's depiction of a dress would not grant the owner of a copyright in his painting an *additional* right, unavailable to the owner of a copyright in *The Starry Night*, to manufacture an *undecorated* dress of

the same size and shape as the one in Klimt's painting. Under 17 U.S.C. 113(b), the Copyright Act "does not afford, to the owner of copyright in a work that portrays a useful article as such, any greater or lesser rights with respect to the making, distribution, or display of the useful article so portrayed" than he would have had before the 1976 Act became effective. When it enacted that provision, Congress understood, based on reports from the Copyright Office, that it was preserving a legal regime under which "copyright protection would not extend to * * * [a] copyrighted picture of a dress, used to manufacture the dress." *1961 Register Report* 14; see 1976 House Report 105; House Comm. on the Judiciary, 89th Cong., 1st Sess., *Supplementary Register's Report on the General Revision of the U.S. Copyright Law* 47-48 (Comm. Print 1965); see also *Jack Adelman, Inc.* v. *Sonners & Gordon, Inc.*, 112 F. Supp. 187, 188 (S.D.N.Y. 1934) (distinguishing artist's "exclusive right to make copies or reprints of [a] drawing" depicting a dress from the "'exclusive right to make and sell'" a "'garment[]'") (citation omitted).

A copyright in the Klimt painting, however, would also not confer *fewer* rights than a copyright in *The Starry Night*. The right to "reproduce the work in or on any kind of article, whether useful or otherwise," 17 U.S.C. 113(a), is not subject to any explicit or implicit exception for reproduction on a dress. Accordingly, if someone were to manufacture a dress shaped like the one in Klimt's painting, as Section 113(b) permits, Section 113(a) would give Klimt's work the same protection as *The Starry Night* with respect to reproduction on such a dress:

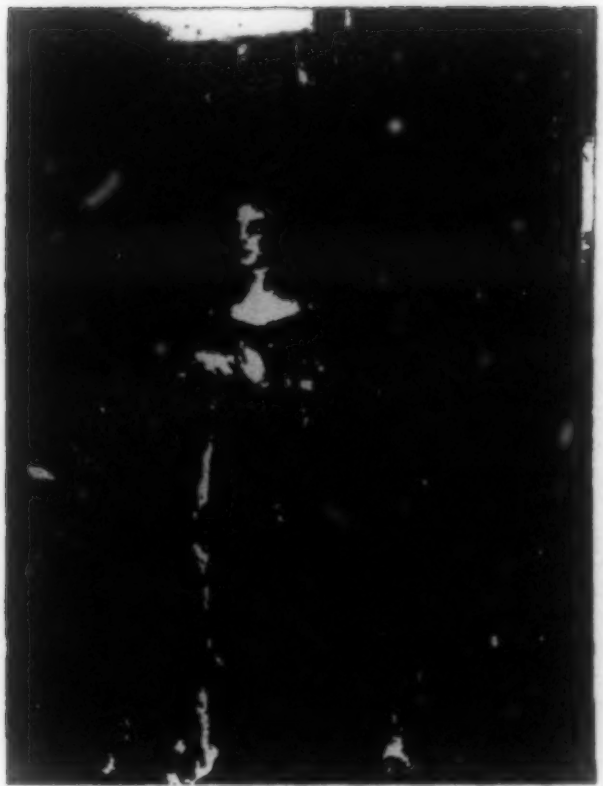

Fig. 6: Doll in Klimt Dress

3. As it comes to this Court, this case presents a situation indistinguishable from the ones just discussed. Petitioner "does not contest" (Br. 51) that the drawings respondents deposited with the Copyright Office to obtain registrations (Pet. App. 5a, 7a, 9a) are copyrightable as drawings. Nor, for present purposes, does petitioner contest that the garment decorations depicted in those drawings are creative enough to satisfy the Copyright Act's originality requirement. See *id.* at 12a (observing that originality was contested but not decided below).

Respondents are thus in the same position with respect to their drawings as the owner of a copyright in *The Starry Night* or the Klimt painting would be with respect to those works. In particular, respondents

would have the exclusive right to reproduce their drawings on a garment, whether that garment is a t-shirt, a wedding gown, or a garment shaped exactly like the ones that the drawings depict.

Under Section 113(b), because the cut and shape of a garment define the "useful article as such," respondents could not preclude anyone from manufacturing this garment:

Fig. 7: Undecorated Garment

But under Section 113(a), they *would* have the exclusive right to reproduce one of their drawings on that garment, to make it look like this:

Fig 8: Garment Copying Respondents' Drawing

4. Petitioner appears (Br. 47) to view the two garments above as fundamentally different useful articles: the first a "little black dress," and the second a more functional "cheerleader uniform." A copyright owner's exclusive rights under Section 113(a) are

limited to the "reproduc[tion]" of a copyrighted work "in or on" a useful or non-useful article. Section 113(a) does not grant the copyright owner any exclusive right to transform one type of useful article into another type of useful article with different, or enhanced, "utilitarian function[s]," 17 U.S.C. 101. Accordingly, if petitioner were correct in viewing the second garment as having utilitarian functions that the first does not, then Section 113(a) would not protect the application of the decorations that is illustrated above.

Petitioner's approach, however, cannot be reconciled with the statutory definition of "useful article." In petitioner's view, the decoration (1) "cause[s] an observer to perceive the wearer as a cheerleader," Br. 46; (2) focuses an observer's attention on particular portions of the uniform, Br. 47; and (3) alters "how the wearer's body is perceived," Br. 48. For Copyright Act purposes, those distinctions are not properly viewed as altering any utilitarian aspect of the garment to which the design is applied.

The Copyright Act defines the term "useful article" to mean "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." 17 U.S.C. 101. Under that definition, "portray[ing] the appearance of [an] article" or "convey[ing] information" is not the sort of function that renders an article "useful." See Pet. App. 38a. Identifying the wearer as a cheerleader is "convey[ing] information." Focusing an observer's eye on particular parts of a garment is "portray[ing] the appearance of the article." And changing a viewer's perception of the wearer's body is an ancillary effect of the article's self-portrayal that

cannot properly be considered "utilitarian." See *Webster's Third New International Dictionary of the English Language* 2525 (1976) (defining "utilitarian" as "characterized by or aiming at utility as distinguished from beauty or ornament"). Indeed, if the potential to change the viewer's perception of the wearer were treated for this purpose as a utilitarian function, *every* artistic object would be a useful article, since all artwork affects a viewer's perception of nearby objects at least to some degree. See, *e.g.*, Edith Wharton & Ogden Codman, Jr., *The Decoration of Houses* 46 (1898) ("It must never be forgotten that pictures on a wall, whether set in panels or merely framed and hung, inevitably become part of the wall-decoration."); see also Pet. App. 44a (rejecting approach that "would render nearly all artwork unprotectable").

Petitioner interprets the word "merely" in the phrase "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information" to imply that, if an article has *one* "utilitarian function," then "convey[ing] information" and "portray[ing] the appearance of the article" become relevant "utilitarian function[s]" as well. See Br. 53-54. That interpretation turns on an unnatural reading in which "merely" modifies a more distant verb ("having") rather than a closer one ("is"). See *Sorenson* v. *Secretary of the Treasury*, 475 U.S. 851, 862 (1986) (deeming it "far more plausible" that phrase "modif[ied] the nearest verb"); Antonin Scalia & Bryan A. Garner, *Reading Law* 152-153 (2012) (discussing nearest-reasonable-referent canon); see also *Lockhart* v. *United States*, 136 S. Ct. 958, 962-963 (2016) (discussing "last ante-

cedent principle"). And it would divest a copyright owner of Section 113(a) rights in many common situations, including printing a hockey-team logo on a jersey to identify the wearer as a team member or fan; placing a picture on a container to identify its contents; or attaching a hood ornament to a car to mark its brand, see Pet. Br. 34.

5. Two of respondents' registrations are based on deposits of photographs of decorations appearing on the surface of actual garments. See Pet. App. 6a, 8a. The court of appeals did not understand respondents to be asserting any greater rights (*e.g.*, rights relating to how the garment was constructed) in those works than in the works for which respondents had deposited drawings. Rather, the court viewed all five works at issue as "two-dimensional works of graphic art," *id.* at 42a (ellipses and citation omitted), that could equally be illustrated either through a drawing or through application to a physical garment, as captured in a photograph. Petitioner likewise treats all five works as presenting the same basic copyrightability question.

Respondents possess the same rights in their two-dimensional artwork regardless of whether the work was first created on paper or on fabric shaped as a garment. See *Mazer*, 347 U.S. at 218-219 (finding no distinction between registration of work already incorporated into manufactured article and registration of work not yet incorporated into manufactured article). "Copyright protection subsists * * * in original works of authorship fixed in any tangible medium of expression, * * * from which they can be perceived." 17 U.S.C. 102(a). Just as *The Starry Night* would have been copyrightable if it had originally been cre-

ated on a dress, the works for which respondents submitted photographs of decorated garments are eligible for copyright on the same terms as those for which they submitted drawings.

B. Respondents' Works Are Copyright-Eligible Under 17 U.S.C. 101 Because They Are Conceptually Separable From Any Actual Garments That They Are Used To Decorate

The result is the same if this case is instead viewed, as it was in the lower courts, as turning on whether respondents' works satisfy the prerequisites for copyright protection of the "design of a useful article" under 17 U.S.C. 101. The Section 101 analysis is the mirror image of the Section 113 analysis. Section 113 protects displaying an otherwise-copyrightable work on the medium of a useful article, but not functionally intertwining the two. Section 101 provides a rubric for determining whether a useful article is the medium for displaying an otherwise-copyrightable work, or is instead functionally intertwined with it. Here, a particular garment is a medium for displaying respondents' works, which are therefore copyrightable if they are sufficiently original.

1. Section 101 states that "the design of a useful article * * * shall be considered" copyright-eligible "only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." 17 U.S.C. 101. A feature of a useful article therefore is potentially copyrightable so long as the feature neither meaningfully affects one of the article's relevant utilitarian functions (in which case the feature cannot "be identified separately from" the

function) nor is capable of performing one of those functions without the article (in which case the feature cannot "exist[] independently" of the function).

Section 101 thus generally will not allow for a copyright in "the shape of an industrial product," even if that shape is "determined by esthetic (as opposed to functional) considerations." 1976 House Report 55. The shape of a "ladies' dress" (*ibid.*), for example, determines how it covers the wearer's body and thus cannot be identified separately from that utilitarian function. Section 101 generally authorizes copyright protection, however, for the two-dimensional surface decoration of a useful article. A "two-dimensional painting, drawing, or graphic work * * * printed on or applied to utilitarian articles such as textile fabrics, wallpaper, containers, and the like" is "still capable of being identified as such," independent of anything useful that the article does. 1976 House Report 55. And such artwork could easily be copied to a different medium (*e.g.*, a poster, or a papier-mâché facsimile of the original article) without replicating any of the article's relevant functionality.

The two-dimensional decorations at issue here can be identified separately from the utilitarian aspects of a garment to which they are applied because—for reasons discussed above, see pp. 23-24, *supra*—they do not affect any of the garment's relevant utilitarian functions. Respondents' decorations "do not enhance [the garment's] functionality *qua* clothing," as a "plain white" garment of identical shape and material would "still cover the body and permit the wearer to cheer, jump, kick, and flip." Pet. App. 45a (internal quotation marks and citation omitted). And respondents' works can exist independently of a garment's utilitari-

an aspects because they can be reproduced on other media—such as a piece of paper, or a stone carving shaped like a garment—without replicating any of those utilitarian aspects.

The phrase "utilitarian aspects of the article" is most naturally understood to refer to the "intrinsic utilitarian function[s]" that make the article "useful" in the first place. 17 U.S.C. 101; see, *e.g.*, *Koons Buick Pontiac GMC, Inc.* v. *Nigh*, 543 U.S. 50, 60 (2004) ("Statutory construction is a holistic endeavor.") (internal quotation marks and citations omitted). If that were not so, application of Section 101 would be asymmetric with application of Section 113, rendering the choice of approaches outcome-determinative in many cases and frustrating Congress's intent that the two provisions fit together harmoniously. See 1976 House Report 54, 105.

2. In *Mazer*, this Court attached significant weight to "the practice of the Copyright Office" in determining the copyrightability of a work incorporated into a useful article. 347 U.S. at 213; see *id.* at 211-213, 218. The Copyright Office's interpretation of the current statutory language—which itself "is an adaptation of language added to the Copyright Office Regulations in the mid-1950's," 1976 House Report 54-55—warrants similar, if not greater, weight. See, *e.g.*, *United States* v. *Mead Corp.*, 533 U.S. 218, 227-228 (2001) (explaining that courts "properly" draw "guidance" from an implementing agency's "experience and informed judgment" and should attach "considerable weight" to the agency's "construction of a statutory scheme it is entrusted to administer") (citations omitted).

Consistent with its pre-1976 Act practices, the Copyright Office will register a copyright in an origi-

nal and expressive feature of a useful article if the feature is either (1) "physically" separable from the article, *Compendium III* § 924.2(A), or (2) "conceptually" separable from the article, in that "the artistic feature and the useful article could both exist side by side and be perceived as fully realized, separate works—one an artistic work and the other a useful article," *id.* § 924.2(B). In the Copyright Office's experience, that approach, which expands on terminology in the 1976 House Report, supplies a helpful practical framework for implementing the statutory text. See 1976 House Report 55 (emphasizing copyrightability of features "that, physically or conceptually, can be identified as separable"). If the work and the article can be visualized as two different things, with the article remaining similarly useful (and the work non-useful), then the work can be "identified separately" and "exist[] independently" of the article, 17 U.S.C. 101.

As the Copyright Office has explained in guidance issued following notice-and-comment procedures, a "two-dimensional design applied to the surface of * * * clothing" is typically copyrightable under that framework. 56 Fed. Reg. at 56,531; see *Compendium III* § 924.3(A)(1) (explaining that "designs imprinted in or on fabric are considered conceptually separable from the utilitarian aspects of garments"); *ibid.* (explaining that a dress's "fabric design" is potentially copyrightable); see also *id.* § 924.2(B) (identifying "[a]rtwork printed on a t-shirt" as an example of copyrightable design); pp. 8-10, *supra*. Here, "a graphic design and a blank cheerleading uniform can appear 'side by side'—one as a graphic design, and one as a

cheerleading uniform." Pet. App. 46a (citing *Compendium III* § 924.2(B)).

Application of the conceptual-separability test in this case does not require an abstract definition of "cheerleading-uniform-ness." Cf. Pet. App. 58a-59a. It instead consists of a practical examination of whether removing respondents' decorations from a garment would meaningfully impair or eliminate any of the garment's relevant functionality, and whether the decorations could be adequately (and nonfunctionally) displayed on a medium other than that garment. For reasons already discussed, see pp. 23-24, 27-28, *supra*, the decorations are conceptually separable from garments under that approach.

3. Petitioner contends (Br. 48-49) that respondents' decorations are inseparable from the garments depicted in their deposit materials because the decorations reflect an awareness of, and were intended to correspond to, the (noncopyrightable) shapes of those garments. The force of that contention is substantially undercut by evidence that respondents' decorations "are transferrable to" other types of garments, Pet. App. 46a, as illustrated below:

Fig. 9: Decorated Top and Decorated Jacket

But even accepting that respondents' designs were intended to, and do, look best on garments of certain shapes, those designs remain conceptually separable

from the garments themselves and therefore eligible for copyright protection.

Essentially any work that would be subject to the separability test to begin with—that is, any work that could be characterized as the "design of a useful article"—is likely to have some correlation with the optimal shape of its intended display medium. Congress did not intend that sort of relationship to preclude copyright protection. Congress understood, for example, that "a floral relief design on silver flatware" would be copyrightable under Section 101. 1976 House Report 55. As illustrated below, however, such a design must necessarily conform to the (noncopyrightable) shape of the flatware, and would need to be resized or otherwise adjusted for wider or narrower flatware:

Fig. 10: Flatware with Floral Relief Design

More generally, much (if not all) artwork is influenced to at least some degree by the shape of its intended display medium. *The Starry Night* would look different if Van Gogh had painted it on a differently proportioned canvas. So too would Constantino Brumidi's *The Apotheosis of Washington* (reproduced below), which Brumidi painted on a commission "to furnish a design for 'a picture 65 feet in diameter, painted in fresco, on the concave canopy over the eye of the new dome of the U.S. Capitol,'" and which accordingly includes figures arranged in a circular pattern and "painted to be intelligible from close up as well as from 180 feet below." Architect of the Capitol, *Apotheosis of Washington*, https://www.aoc.gov/art/other-paintings-and-murals/apotheosis-washington (last visited Sept. 19, 2016).

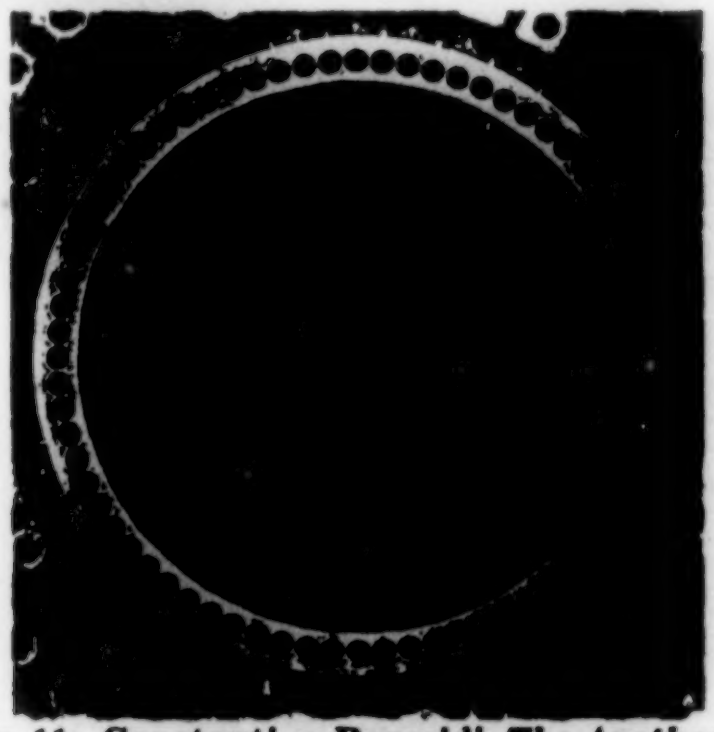

Fig. 11: Constantino Brumidi, *The Apotheosis of Washington* (1865)

4. The court of appeals correctly understood this case to involve the relatively straightforward circumstance in which copyright is claimed only in "two-dimensional" surface decoration for a useful article. See Pet. App. 4a, 42a. Even as applied to garments, respondents' decorations are properly viewed as "two-dimensional" because they can, with certain application techniques, exist solely on the two-dimensional surface of a garment without altering the garment's three-dimensional shape. See *id.* at 4a & n.1 (discussing application techniques); Martin Gardner, *The Colossal Book of Mathematics* 137 (2001) (explaining that the surface of a sphere "is two-dimensional" even though the sphere itself is three-dimensional). This case accordingly does not provide an appropriate vehicle for addressing the more difficult issues that may be presented by three-dimensional designs of useful articles, which will more often affect those articles' structure or function.

Petitioner also contends (Br. 47-48) that, when it produced its allegedly infringing cheerleader uniforms, it used "braiding" (or "striped fabric strips") that simultaneously performed both decorative and utilitarian functions. Petitioner is correct that the use of fabric strips "to create style lines and to minimize the stretching of neck and waist openings while strengthening the neck and waist hems and hem stitching" (*ibid.*) is the sort of design technique that cannot receive copyright protection. But respondents' arrangements of shapes and colors, *qua* shapes and colors, perform a purely decorative function. They can be placed on a garment using techniques that do not involve distinct fabric strips. See Pet. App. 4a. Conversely, petitioner can use fabric strips to mini-

mize stretching and to strengthen hems without infringing any copyrights so long as it does not mimic respondents' decorative schemes. The fact that the same strips of material can be used to achieve both decorative and functional ends, or that petitioner utilized such dual-purpose strips in manufacturing its own uniforms, does not preclude copyright protection for the two-dimensional decorations themselves.

C. Petitioner's Approach To Copyrightability Is Unsound

1. Contrary to petitioner's contention, the statutory definition of pictorial, graphic, and sculptural works does not "create[] a presumption against copyright protection for the design of [a] useful article," Br. 27 (emphasis omitted). In order to be "as clear * * * as possible" about the scope of copyright protection, Congress directed that the design of a useful article is protectable "'only if, and only to the extent that,'" it is separable from the article's utilitarian aspects. 1976 House Report 54-55. That language does not imply that a presumption of non-separability controls the outcome of individual cases. Some Copyright Act provisions explicitly create presumptions, see, *e.g.*, 17 U.S.C. 113(d), 201(c), 302(e), 410(c), and due weight should be given to Congress's decision not to include similar language in Section 101, see, *e.g.*, *Department of Homeland Sec.* v. *MacLean*, 135 S. Ct. 913, 919 (2015) ("Congress generally acts intentionally when it uses particular language in one section of a statute but omits it in another.").

The Copyright Act's history does not "confirm[]" (Pet. Br. 27), but instead discountenances, a presumption against copyrightability. "In accordance with" *Mazer*, Congress crafted the relevant language to allow for copyrights in "*all* original, pictorial, graphic,

and sculptural works that are intended to be or have been embodied in useful articles, regardless of factors such as * * * the potential availability of design patent protection." 1976 House Report 54 (emphasis added); see *Mazer*, 347 U.S. at 217; see also, *e.g.*, *J.E.M. AG Supply, Inc.* v. *Pioneer Hi-Bred Int'l, Inc.*, 534 U.S. 124, 138-144 (2001) (recognizing that intellectual-property schemes may "overlap" and provide "dual protection"). And Congress was aware, in codifying *Mazer* and the Copyright Office's post-*Mazer* practices, that it was endorsing legal principles under which the Copyright Office had registered many works that could be described as the designs of useful articles. See 347 U.S. at 213-218; *1975 Hearing* 1857; *1961 Register Report* 12.

In suggesting otherwise, petitioner conflates the "design of a useful article," 17 U.S.C. 101, with the sorts of "industrial designs" and "garment designs" to which Congress has generally declined to grant intellectual-property protection (in copyright law or otherwise), Pet. Br. 28-29. The latter terms refer to broader protection for the designs of, *e.g.*, the shapes of garments and other industrial objects, which would apply even when the design *cannot* be separated from the article's useful aspects. See 1976 House Report 55 (distinguishing "uncopyrighted works of industrial design" from the sort of "applied art" at issue here); see, *e.g.*, H.R. 2196, 111th Cong., 1st Sess. § 2(a)(2)(B) (2009) (unenacted bill for protecting "fashion design," defined to include "the appearance as a whole of an article of apparel"); see also, *e.g.*, 17 U.S.C. 1301 (omitting separability requirement from special protection of boat-hull designs). The Copyright Office policy decision on which petitioner repeatedly relies

(Br. 6, 11, 28, 44), while recognizing that "industrial design[s]" and "[g]arment designs" are not copyrightable, explains that a "two-dimensional design applied to the surface of * * * clothing may be registered" under existing law. 56 Fed. Reg. at 56,530-56,531 (citation omitted).

2. Analysis of a work's separability from a useful article should not include amorphous considerations of the work's "design process" or "marketability." Pet. Br. 34-37. Such an approach could lead to inconsistent treatment of identical works and would undermine the copyright-registration process.

The 1976 codification of *Mazer*, in which this Court had treated both design process and marketability as irrelevant, demonstrates that Congress did not intend to incorporate either factor into the copyrightability analysis. The statuette in *Mazer* was designed by lamp manufacturers, not independent artists, 347 U.S. at 202; was "intended to be reproduced for lamp bases," *id.* at 205; and was sold in "fully equipped lamps," *id.* at 203. The market rejected the statuette as a standalone work, as "sales in lamp form accounted for all but an insignificant portion of [overall] sales." *Ibid.* The Court nevertheless "f[oun]d nothing in the copyright statute to support the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration." *Id.* at 218. The 1976 House Report not only endorsed the specific result in *Mazer*, 1976 House Report 55, but "[i]n accordance with" *Mazer*, described "inten[t] to * * * embod[y]" a work in a useful article, "mass production," and "commercial exploitation" as irrelevant to a work's copyrightability, *id.* at 54.

Consideration of the extrinsic factors identified by petitioner is unwarranted for the additional reason that such consideration would frustrate the Copyright Act's registration scheme. The Act requires registration of a work whenever the Copyright Office "determines" that the "legal and formal requirements of this title have been met" and that "the material deposited constitutes copyrightable subject matter." 17 U.S.C. 410(a). The Copyright Act requires the "material deposited" to include one or more copies of the work itself, 17 U.S.C. 408(b), but it does not contemplate the submission of evidence about collateral matters such as design process or marketability. Although the Copyright Office has broad general authority over the registration process, see 17 U.S.C. 409(10), 702, it has limited authority to require additional deposit material, 17 U.S.C. 408(c)(1), and it has never required applicants for registration to provide the sort of extrinsic evidence that would be needed to evaluate design process and marketability, see, *e.g.*, 37 C.F.R. 202.3, 202.10.

The statutory directive that the Copyright Office determine copyrightability based only on the deposit material demonstrates Congress's commitment to a registration process that is not substantially burdensome to either the agency or the applicants. See U.S. Copyright Office, *Fiscal 2014 Annual Report* 10 (2014), http://www.copyright.gov/reports/annual/2014/ar2014.pdf (noting that the Copyright Office registered 88,703 works of visual arts in FY2014). The registration provisions, which allow registration within five years of publication to serve as "prima facie evidence of the validity of the copyright," 17 U.S.C. 410(c), also reflect Congress's intent to "promote[] efficient

litigation practices," H.R. Rep. No. 609, 100th Cong., 2d Sess 41 (1988), by obviating the need to litigate copyrightability in every infringement case. But because courts considering copyrightability are not limited to the evidence available to the Copyright Office at the time of the *ex parte* registration, petitioner's approach would give parties incentives to tie up the courts (as petitioner has here) with extensive discovery and claims that the Copyright Office overlooked or misapprehended aspects of a work's design process or marketability.

3. Contrary to petitioner's suggestions (*e.g.*, Br. 6), treating the designs at issue here as potentially copyrightable would not allow respondents to corner the market for cheerleading uniforms.

First, not all decorations intended for cheerleading uniforms will be sufficiently creative to qualify for copyright protection. Although most works exhibit the "minimal level of creativity" necessary to qualify as original, "[t]here remains a narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent." *Feist Publ'ns, Inc.*, 499 U.S. at 358-359. Petitioner remains free to argue on remand that the works at issue here fall into that category.

Second, copyright protects only expression, not ideas. See 17 U.S.C. 102(b); *Golan* v. *Holder*, 132 S. Ct. 873, 890 (2012). Copyrights in respondents' works therefore would not preclude petitioner or others from manufacturing and selling garments or accessories with different decorations that are likewise evocative of cheerleading. Indeed, as the following *Saturday Evening Post* cover from 1952 illustrates,

decorations evocative of cheerleading are not immutable, but have evolved over time:

Fig. 12: Norman Rockwell, *Cheerleaders* (1952)

And even assuming that cheerleading today can be evoked only through "stripes, chevrons, zigzags, and lines" of the sort in respondents' works, Pet. Br. 16, respondents' own view that many works with those elements are distinct enough to be separately copyrightable, see Pet. App. 4a, suggests substantial room for future non-infringing decorations by respondents' competitors.

Third, if it were impossible to create a garment evocative of cheerleading without copying one of respondents' designs, then the Act would permit such copying. This Court recognized in *Baker* v. *Selden*, 101 U.S. 99 (1880), that if a copyrighted book describes (uncopyrightable) concepts that "cannot be used without employing the * * * diagrams used to

illustrate the book, or such as are similar to them," then those "diagrams are to be considered as necessary incidents to the art, and given therewith to the public." *Id.* at 103; see *id.* at 103-104 (distinguishing such public-domain diagrams from "ornamental designs" and "pictorial illustrations addressed to the taste"). Similar principles would preclude leveraging a copyright in garment decoration to prevent others from evoking the idea of cheerleading. See, *e.g.*, 4 Nimmer § 13.03[B][3], at 13-86 to 13-87 (explaining that "merger" doctrine permits use of copyrighted expression when it is the only way to express an idea); see also, *e.g.*, *Lexmark Int'l, Inc.* v. *Static Control Components, Inc.*, 387 F.3d 522, 535-536 (6th Cir. 2004) (explaining that, under "scènes-à-faire" doctrine, certain "stock" elements of an idea may not receive copyright protection) (citation omitted).

CONCLUSION

The judgment of the court of appeals should be affirmed.

Respectfully submitted.

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APPENDIX

1. 17 U.S.C. 101 provides in pertinent part:

Definitions

Except as otherwise provided in this title, as used in this title, the following terms and their variant forms mean the following:

* * * * *

"Pictorial, graphic, and sculptural works" include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

* * * * *

A "useful article" is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a "useful article".

* * * * *

2. 17 U.S.C. 102 provides:

Subject matter of copyright: In general

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

(1) literary works;

(2) musical works, including any accompanying words;

(3) dramatic works, including any accompanying music;

(4) pantomimes and choreographic works;

(5) pictorial, graphic, and sculptural works;

(6) motion pictures and other audiovisual works;

(7) sound recordings; and

(8) architectural works.

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

3. 17 U.S.C. 106 provides:

Exclusive rights in copyrighted works

Subject to sections 107 through 122, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

(1) to reproduce the copyrighted work in copies or phonorecords;

(2) to prepare derivative works based upon the copyrighted work;

(3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;

(4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;

(5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and

(6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

4. 17 U.S.C. 113 provides in pertinent part:

Scope of exclusive rights in pictorial, graphic, and sculptural works

(a) Subject to the provisions of subsections (b) and (c) of this section, the exclusive right to reproduce a copyrighted pictorial, graphic, or sculptural work in copies under section 106 includes the right to reproduce the work in or on any kind of article, whether useful or otherwise.

(b) This title does not afford, to the owner of copyright in a work that portrays a useful article as such, any greater or lesser rights with respect to the making, distribution, or display of the useful article so portrayed than those afforded to such works under the law, whether title 17 or the common law or statutes of a State, in effect on December 31, 1977, as held applicable and construed by a court in an action brought under this title.

(c) In the case of a work lawfully reproduced in useful articles that have been offered for sale or other distribution to the public, copyright does not include any right to prevent the making, distribution, or display of pictures or photographs of such articles in connection with advertisements or commentaries related to the distribution or display of such articles, or in connection with news reports.

* * * * *

5. 17 U.S.C. 408 provides in pertinent part:

Copyright registration in general

(a) REGISTRATION PERMISSIVE.—At any time during the subsistence of the first term of copyright in any published or unpublished work in which the copyright was secured before January 1, 1978, and during the subsistence of any copyright secured on or after that date, the owner of copyright or of any exclusive right in the work may obtain registration of the copyright claim by delivering to the Copyright Office the deposit specified by this section, together with the application and fee specified by sections 409 and 708. Such registration is not a condition of copyright protection.

(b) DEPOSIT FOR COPYRIGHT REGISTRATION.—Except as provided by subsection (c), the material deposited for registration shall include—

(1) in the case of an unpublished work, one complete copy or phonorecord;

(2) in the case of the published work, two complete copies or phonorecords of the best edition;

(3) in the case of a work first published outside the United States, one complete copy or phonorecord as so published;

(4) in the case of a contribution to a collective work, one complete copy or phonorecord of the best edition of the collective work.

Copies or phonorecords deposited for the Library of Congress under section 407 may be used to satisfy the

deposit provisions of this section, if they are accompanied by the prescribed application and fee, and by any additional identifying material that the Register may, by regulation, require. The Register shall also prescribe regulations establishing requirements under which copies or phonorecords acquired for the Library of Congress under subsection (e) of section 407, otherwise than by deposit, may be used to satisfy the deposit provisions of this section.

* * * * *

6. 17 U.S.C. 409 provides:

Application for copyright registration

The application for copyright registration shall be made on a form prescribed by the Register of Copyrights and shall include—

(1) the name and address of the copyright claimant;

(2) in the case of a work other than an anonymous or pseudonymous work, the name and nationality or domicile of the author or authors, and, if one or more of the authors is dead, the dates of their deaths;

(3) if the work is anonymous or pseudonymous, the nationality or domicile of the author or authors;

(4) in the case of a work made for hire, a statement to this effect;

(5) if the copyright claimant is not the author, a brief statement of how the claimant obtained ownership of the copyright;

(6) the title of the work, together with any previous or alternative titles under which the work can be identified;

(7) the year in which creation of the work was completed;

(8) if the work has been published, the date and nation of its first publication;

(9) in the case of a compilation or derivative work, an identification of any preexisting work or works that it is based on or incorporates, and a brief, general statement of the additional material covered by the copyright claim being registered; and

(10) any other information regarded by the Register of Copyrights as bearing upon the preparation or identification of the work or the existence, ownership, or duration of the copyright.

If an application is submitted for the renewed and extended term provided for in section 304(a)(3)(A) and an original term registration has not been made, the Register may request information with respect to the existence, ownership, or duration of the copyright for the original term.

7. 17 U.S.C. 410 provides:

Registration of claim and issuance of certificate

(a) When, after examination, the Register of Copyrights determines that, in accordance with the provisions of this title, the material deposited constitutes copyrightable subject matter and that the other legal and formal requirements of this title have been met, the Register shall register the claim and issue to the applicant a certificate of registration under the seal of the Copyright Office. The certificate shall contain the information given in the application, together with the number and effective date of the registration.

(b) In any case in which the Register of Copyrights determines that, in accordance with the provisions of this title, the material deposited does not constitute copyrightable subject matter or that the claim is invalid for any other reason, the Register shall refuse registration and shall notify the applicant in writing of the reasons for such refusal.

(c) In any judicial proceedings the certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate. The evidentiary weight to be accorded the certificate of a registration made thereafter shall be within the discretion of the court.

(d) The effective date of a copyright registration is the day on which an application, deposit, and fee,

which are later determined by the Register of Copyrights or by a court of competent jurisdiction to be acceptable for registration, have all been received in the Copyright Office.

8. 17 U.S.C. 702 provides:

Copyright Office regulations

The Register of Copyrights is authorized to establish regulations not inconsistent with law for the administration of the functions and duties made the responsibility of the Register under this title. All regulations established by the Register under this title are subject to the approval of the Librarian of Congress.

9. 56 Fed. Reg. 56530, 56531 (Nov. 5, 1991) provides in pertinent part:

* * * * *

The Copyright Office has generally refused to register claims to copyright in three-dimensional aspects of clothing or costume design on the ground that articles of clothing and costumes are useful articles that ordinarily contain no artistic authorship separable from their overall utilitarian shape. A two-dimensional design applied to the surface of the clothing may be registered, but this claim to copyright is generally made by the fabric producer rather than the garment or costume designer. Moreover, this claim to copyright is ordinarily made when the two-dimensional design is

applied to the textile fabric and before the garment is cut from the fabric.

* * * * *

10. U.S. Copyright Office, *Compendium of U.S. Copyright Office Practices* (3d ed. 2014) provides in pertinent part:

* * * * *

924 **Registration Requirements for Useful Articles**

As discussed in Section 906.8, "useful articles" are not protected by copyright law. However, the purely ornamental or decorative pictorial, graphic, or sculptural features of a useful article may be registered if they can be identified separately from, and are capable of existing as works of authorship independently of, the utilitarian aspects of that article. 17 U.S.C. § 101 (definition of "pictorial, graphic, and sculptural works"). This Section explains what types of works are considered useful articles and how to determine if they contain sufficiently separable elements to warrant registration.

924.1 **What Is a Useful Article?**

The Copyright Act defines a useful article as "an article having an intrinsic utilitarian function that is not merely to portray the

appearance of the article or to convey information." 17 U.S.C. § 101. An item or object is considered a useful article if it performs any inherent or intrinsic utilitarian function other than to inform, entertain, or portray its appearance to human beings. Examples of useful articles include automobiles, household appliances, furniture, lighting fixtures, work tools, dinnerware, food, clothing, shoes, personal computers, and carrying cases for laptops.

The statute also states that "[a]n article that is normally part of a useful article is considered a 'useful article.'" *Id.* For example, the bezel on a wristwatch or the handle on a casket would be considered useful articles, because they are inherently useful and because they are typically used as part of a larger useful article.

The mechanical or utilitarian aspects of a three-dimensional work of applied art are not copyrightable. For example, the serrated edge of a knife cannot be registered, even if the pattern of the serration is original.

A work of authorship that does not have an intrinsic utilitarian purpose is not considered a useful article, even if that work could potentially be used in a functional manner. For example, a sculpture does not become a useful article simply because

it could be used as a doorstop or paperweight.

924.2 **Separability Tests for Useful Articles**

Sections 101 and 102(a) of the Copyright Act provide the guiding principles for determining whether the decorative or ornamental features of a useful article may be registered with the U.S. Copyright Office. Section 102(a)(5) of the Act states that the copyright law protects "pictorial, graphic, and sculptural works," which are defined by section 101 to include "two-dimensional and three-dimensional works of fine, graphic, and applied art" as well as "works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned." The statute also states that "the design of a useful article . . . shall be considered a pictorial, graphic, or sculptural work, only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." 17 U.S.C. § 101 (definition of "pictorial, graphic and sculptural works").

When examining a useful article, the Office must determine whether the article contains any pictorial, graphic, or sculptural features that are separable from its utili-

tarian function. If the article does not contain any features that can be separated from its utilitarian function, the Office will refuse to register the claim, because Congress has made it clear that the Copyright Act does not cover any aspect of a useful article that cannot be separated from its functional elements. H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5668-69. If the Office determines that the work contains one or more features that can be separated from its functional elements, the Office will examine those features to determine if they contain a sufficient amount of original authorship to warrant registration.

The Office will register claims to copyright in useful articles only on the basis of separately identifiable pictorial, graphic, or sculptural features. These features should be capable of independent existence apart from the overall shape of the useful article. The Office uses two tests to determine if the useful elements of an article are separable from the copyrightable elements: the physical and conceptual separability tests. These tests are discussed in Sections 924.2(A) and 924.2(B).

924.2(A) **Physical Separability**

The useful elements of an article will be considered separable from the copyrighta-

ble elements if the copyrightable elements could be physically removed without altering the useful aspects of the article. This is known as the physical separability test. Physical separability means that the useful article contains pictorial, graphic, or sculptural features that can be physically separated from the article by ordinary means while leaving the utilitarian aspects of the article completely intact.

Example:

- A sufficiently creative decorative hood ornament on an automobile.

924.2(B) **Conceptual Separability**

The U.S. Copyright Office applies the conceptual separability test only if it determines that the useful article contains pictorial, graphic, or sculptural features that cannot be physically separated from that article.

Conceptual separability means that a feature of the useful article is clearly recognizable as a pictorial, graphic, or sculptural work, notwithstanding the fact that it cannot be physically separated from the article by ordinary means. This artistic feature must be capable of being visualized—either on paper or as a free-standing sculpture—as a work of authorship that is independent from the overall shape of the useful article.

In other words, the feature must be imagined separately and independently from the useful article without destroying the basic shape of that article. A pictorial, graphic, or sculptural feature satisfies this requirement only if the artistic feature and the useful article could both exist side by side and be perceived as fully realized, separate works—one an artistic work and the other a useful article. For example, the carving on the back of a chair or an engraving on a vase would be considered conceptually separable, because one could imagine the carving or the engraving as a drawing on a piece of paper that is entirely distinct from the overall shape of the chair and the vase. Even if the carving or the engraving was removed the shape of the chair and the vase would remain unchanged, and both the chair and the vase would still be capable of serving a useful purpose. H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. at 5668-69.

Examples:

- Artwork printed on a t-shirt, beach towel, or carpet.
- A colorful pattern decorating the surface of a shopping bag.

- A drawing on the surface of wallpaper.
- A floral relief decorating the handle of a spoon.

Merely analogizing the general shape of a useful article to a work of modern sculpture or an abstract sculpture does not satisfy the conceptual separability test, because it does not provide an objective basis for visualizing the artistic features and the useful article as separate and independent works. *See Esquire, Inc. v. Ringer*, 591 F.2d 796, 804 (1978) (D.C. Cir. 1978) (agreeing with the Office's determination that "the overall design or configuration of a utilitarian object, even if it is determined by aesthetic as well as functional considerations, is not eligible for copyright"); *see also Inhale, Inc. v. Starbuzz Tobacco, Inc.*, 739 F.3d 446, 449 (9th Cir. 2014) (finding that the Office's interpretation of conceptual separability is entitled to deference, stating that "[c]ourts have twisted themselves into knots trying to create a test to effectively ascertain whether the artistic aspects of a useful article can be identified separately from and exist independently of the article's utilitarian function").

The fact that a useful article could have been designed differently or the fact that an artistic feature is not necessary to or

dictated by the utilitarian aspects of that article is irrelevant to this analysis. If the feature is an integral part of the overall shape or contour of the useful article, that feature cannot be considered conceptually separable because removing it would destroy the basic shape of the useful article. *See generally* H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. at 5668-69.

924.2(C) Factors Not Relevant in Evaluating Separability

In assessing whether certain elements are physically or conceptually separable from the utilitarian functions of a useful article, registration specialists do not consider the following: (i) the aesthetic value of the design; (ii) the fact that the article could have been designed differently; or (iii) the amount of effort or expense that went into the making of the design. H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. at 5668-69.

924.3 Specific Types of Useful Articles

924.3(A) Clothing Designs

Clothing such as shirts, dresses, pants, coats, shoes, and outerwear are not eligible for copyright protection because they are considered useful articles. This is because clothing provides utilitarian func-

tions, such as warmth, protection, and modesty. As a result, the U.S. Copyright Office will not register a claim in clothing or clothing designs. *See* Registrability of Costume Designs, 56 Fed. Reg. 56,530, 56,531 (Nov. 5, 1991).

924.3(A)(1) **Fabric and Textile Designs Embodied in Clothing or Other Useful Articles**

Although the copyright law does not protect the shape or design of clothing, and although fabric and textiles have useful functions (*e.g.*, providing varying degrees of warmth and protection), designs imprinted in or on fabric are considered conceptually separable from the utilitarian aspects of garments, linens, furniture, or other useful articles. Therefore, a fabric or textile design may be registered if the design contains a sufficient amount of creative expression.

Example:

- Frederique Fallon creates a fabric design with swirls of color and images of people. She uses this fabric to produce a classic A-line dress. Frederique applies to register the fabric design and the dress. The registration specialist will register the fabric design because it is sufficiently crea-

tive, but will refuse to register the dress itself because it is a useful article.